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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,246	01/18/2001	Jonathan Lowther	BKA.0008US	8160
21906	7590	06/15/2007	EXAMINER	
TROP PRUNER & HU, PC 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			RAMAN, USHA	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/765,246	LOWTHERT ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Usha Raman	2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 March 2007.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-28 and 30-34 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-28 and 30-34 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____                          |

***Response to Arguments***

1. Applicant's arguments filed March 20<sup>th</sup>, 2007 have been fully considered but they are not persuasive. Picco teaches a first subset listing of advertisement (schedule of advertisements with program content for a particular geographic area) that is generated by a remote processor in accordance with a statistical data regarding a geographic area, and a second subset of advertisement (a second subset listing of single advertisement that matches a user's characteristics) that is finer tuned to a characteristic of a particular receiver. See column 7, lines 56-67 and column 8, lines 1-5 and figure 9. Accordingly Picco teaches the limitations of independent claim 1.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 7-9, 11-28, and 30-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Picco et al. (US Pat. 6,029,045).

With regards to claims 1 and 11, Picco discloses a system for allowing the use of content (see column 4, lines 51-54) on a content receiver (see column 4, lines 10-16);

Collecting information about one or more characteristics of the receiver (see column 7, lines 15-23);

Providing the collected information to a remote processor based system (data provided to agent 150, see column 7, lines 23-24);

The agent 150 determines based on collected statistical data, the local content that is going to be combined with programming, and therefore determines a schedule or first subset listing of the local content (advertising resources) with programming.

See column 7, lines 28-31. The local content further comprises content profiles or "guidelines" for distributing the advertising materials on the receiver. See column 6, lines 62-67. Picco accordingly meets the limitation of the receiver receiving, from the remote processor-based system, a first subset listing of advertising resources and guidelines for distributing advertising materials on the receiver, the first subset listing of advertising resources selected from a database of advertising resources based on at least one of the one or more characteristics of the receiver.

Picco additionally discloses that only select receivers matching the criteria of the distribution variable of the local content may download the local content. See column 7, lines 56-67, and column 8, lines 1-5 and figure 9. Therefore, while an agent may determine the scheduling of five advertisements combined with a particular programming, only the advertisements may match the distribution variable

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(e.g. only one advertisement matches a receiver criteria) at a particular receiver are downloaded. Accordingly Picco teaches the claimed limitation of automatically and selectively choosing on the receiver without user intervention (choosing is based on distribution variable and receiver characteristics), an advertisement resource from the first subset listing based on a given characteristic of the receiver to compile a second subset listing (a single advertisement matching the distribution variable) of advertising resources, the second subset listing of the matched advertisement being finer tuned to a characteristic (downloaded advertisements are based on the geographic statistics as well as receiver characteristics) of the receiver than the first subset listing (which is based on geographic statistics); and capturing (downloading) an advertisement listed on the second subset listing of advertising resources to store the advertisement on the content receiver (see column 7, lines 56-61).

With regards to claims 7, and 17 the system comprises a method as stated above in Claim 1, wherein the advertising has associated an associated content profile, which is compared to the user's profile for storage and playback (see Picco: Col. 7, Line 55 - Col. 8, Line 22). This reads on the claimed determining a characteristic of advertising and comparing it to information about the use of the receiver.

With regards to Claim 8, Picco discloses a method as stated above in Claim 1, wherein a user is operable to select television signals from satellite broadcasting for watching (Col. 5, Lines 10-16). The watching of satellite television signal reads on the claimed enabling a variety of content to be selected for play at any time.

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With regard to claims 9, the system discloses inserting (splicing) advertising data into program while a program is displayed. See column 14, lines 4-13. Accordingly the playback of the programming content is replaced with the playback of the advertisement.

With regards to claims 12 and 25, Picco discloses a method where a user is operable to select television signals from satellite broadcasting for watching (see column 5, lines 10-16). The watching of satellite reads on the claimed enabling a variety of content to be selected for play at any time.

With regards to claims 13 and 26, Picco discloses a method wherein collecting information includes monitoring activities of the user of the receiver (column 11, lines 9-13).

With regards to claims 14 and 27, Picco discloses a method wherein collecting information includes accumulating the collected data (see column 11, lines 9-13). This accumulation of the user data read on the claimed developing a database information about activities undertaken by the user of the receiver.

With regards to claim 15, Picco discloses a method, wherein advertisements are stored in a remote database and a subset of these ads are broadcast to user terminals for selective storage based on user profile information as stated above. This reads on the claimed selecting advertisements stored on the remote processor-based system (ads from the head-end's database) based on information about the user of the receiver (user profile).

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With regards to claims 16 and 30, the advertisement resources are broadcast for storage at the receiver as stated above. The user's terminal must catalog the data it has stored in order to manage and retrieve data (see column 10, lines 62-67). This reads on the claimed local electronic program guide (catalog of files) compiled

With regards to claim 30, the advertisement resources are broadcast for storage at the receiver as stated above. The user's terminal must catalog the data it has stored in order to manage and retrieve data (see column 10, lines 62-67). This reads on the claimed local electronic program guide (catalog of files) compiled without user intervention to the second subset of advertising resources captured from the remote processor. The second subset of advertising resources is based on activity of the user that is finer tuned than the first subset listing as discussed above.

With regards to Claims 18, 19, 23 and 24, Picco discloses a method as stated above in Claim 1, wherein content has an expiration date (Col. 1, Lines 61-67) and a maximum number of times it may be viewed (Col. 7, Lines 1-2). Further, the terminal may remove or overwrite content (Col. 10, Line 62 - Col. 11, Line 1). This reads on the claimed automatically replacing (overwriting) the content with advertising after allowing content to be used for a predetermined amount of time (date or number of views). This further reads on the claimed automatic determination at predetermined times whether to replace the content.

Regarding Claim 20, Picco discloses an article as stated above in Claim 11, further storing instructions that enable the receiver to catalog the advertisements it has stored as stated above. This reads on the claimed automatically compiling a

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receiver-based database of advertising. Additionally, only advertisements matching the receiver characteristics are downloaded, and therefore the database includes a subset of selections from the subset listing.

Regarding Claim 21, see Claim 1 above. It is inherent that such a computer-based terminal must run programming in order to function. This reads on the claimed shell.

Regarding Claim 22, Picco discloses a method as stated above in Claim 21, wherein the system is a television receiver (Col. 5, Lines 12-16).

Regarding claims 28 and 31, wherein advertisements available on the remote processor based system are broadcast to the terminals for storage as stated above. This reads on the claimed accessing of advertisements available on the remote processor-based system. It is inherent that the user's terminal must in some way catalog the data it has stored order to manage and retrieve the data (Col. 10, Lines 62-67). This reads on the claimed compiling a local electronic guide (catalog of files) to advertising resources by accessing (receiving and storing) advertisements available on the remote processor-based system (head-end database of advertisements).

Regarding Claim 32, it is implicit that such television-based advertising must be in one or more known languages. This reads on the claimed advertisements specialized for a particular language.

***Claim Rejections - 35 USC § 103***

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-6 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Picco et al. (US Pat. 6,029,045).

With regards to claim 2, the modified system comprises a method as stated above in Claim 1, wherein the set top box is operable to update content (see Picco: Col. 7, Lines 35-41) by storing selected local content as stated above Examiner further takes official notice that updating content can include the step of adding data thereby expanding the local database. It would have been obvious to one of ordinary skill in the art to further modify the system by combining the subset listing of advertising resources with advertising resources available on the receiver in order to expand the database at the local receiver. The modified system additionally comprises the method of automatically and selectively choosing an advertisement resources previously available on the receiver to create the second subset listing.

See column 10, lines 13-18.

With regard to claim 3, Picco discloses that the set top box permits the user to browse the world wide web while viewing a television program. See column 13, lines 23-26. The set top box additionally determines if a web browser has been activated. See column 14, lines 22-25. While Picco discloses collecting statistics from the

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user, Picco is silent on the step of monitoring web-sites that user has visited and application software that the user has utilized. Examiner takes official notice that it was well known in the art at the time of the invention to monitor a plurality of viewer usage habits at a system, including web-sites user visits and application software used by the user. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system by monitoring a plurality of viewer usage habits, including web-sites visited by the user and application program used so that additional usage data can obtained that enables better customization of advertisements.

With regards to claim 4, the modified system comprises a method as stated above in claim 3, wherein collecting information includes accumulating the collected data (see Picco, column 11, lines 9-13). This accumulation of the user reads on the claimed developing a database of information about activities undertaken by the user of the receiver.

With regards to claim 5, the modified system comprises the step of receiving the first subset of advertising resources from a database of advertising resources located on the remote processor based system based on information about the user of the receiver (see column 6, lines 57-61, and column 7, lines 6-23).

With regards to claims 6, Picco further comprises the step of compiling the second subset based on patterns of a user at the receiver. See column 10, lines 5-10.

With regards to claim 10, the system is silent on the step of controlling the number of times a user may access content other than advertising that is stored on the receiver. Examiner takes official notice that it was well known in the art at the time of the invention to subsidize the cost of a program by displaying advertisement to the viewer every time a user accesses the content. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system by subsidizing the cost of a content by displaying advertising every time a content is accessed, thereby providing the user content usage for a lower cost in return for displaying targeted advertising related to the content and the user.

6. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Picco et al. (US Pat. 6,029,045) in view of Moshfeghi et al. (US Pat. 6,076,166).

With regard to claim 33, the modified system is silent on the step of collecting information about a characteristic of one of hardware and software that is present on the receiver.

Moshfeghi discloses a method of personalization of content (customization of web pages based on user's preferences as well as user's receiver characteristics) at user end by collecting information about the hardware and software (i.e. user's computer environment) on the receiver as part of user profile information. See Moshfeghi: column 1, lines 42-58. Moshfeghi therefore discloses the step of selectively downloading files based on a receiver's characteristic.

It would have been obvious to further modify the system in view of Moshfeghi by collecting information about a characteristic of one of hardware and software so

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that the receiver maybe presented with resources that are based on the receiver's capabilities.

7. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Picco et al. in view of Thomas et al. (US Pat. 2003/0037068).

With regard to claim 34, Picco is silent on the step of detecting a user-initiated pause in content usage and in response to detecting a pause in content usage, automatically interrupting the use of the content to temporarily replace the content with a previously stored advertisement, the place in the content where the pause occurs, if the pause occurs at all is not determined by the content provider.

Thomas discloses detecting pause in content usage, responsive to which interrupting the content temporarily to replace with an advertisement, wherein, the place in the content where the pause occurs, if the pause occurs at all is not determined by a content provider (i.e. user initiated pause). See Thomas: [0011].

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Picco in view of Thomas' teachings by replacing the content with a previously stored advertisement when a pause is detected to present the advertisement to the user. The motivation is to present useful information such as targeted advertisements in accordance with viewer's preferences over the duration of the pause.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usha Raman whose telephone number is (571) 272-7380. The examiner can normally be reached on Mon-Fri: 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

UR



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PRIMARY PATENT EXAMINER